

REMARKS

In the Office Action mailed June 27, 2008, the Examiner rejected claims 1 and 3-17 as follows:

- Claims 1, 4-7, and 10-15 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over U.S. Patent No. 5,932,336 (the “Allen patent”), in view of U.S. Patent No. 4,243,576 to Fischer (the “Fischer patent”).
- Claim 3 was rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Allen patent, in view of the Fischer patent, in further view of U.S. Patent No. 5,869,591 to McKay (the “McKay patent”).
- Claims 8, 9, 16, and 17 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Allen patent, in view of the Fischer patent, and in further view of U.S. Patent No. 5,771,605 to Safdie (the “Safdie patent”).

Applicants respectfully request reconsideration of this application in view of the following comments.

**I. The § 103(a) Rejection of Claims 1, 4-7, and 10-15
Based on the Allen Patent in View of the Fischer Patent**

As mentioned above, claims 1, 4-7, and 10-15 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Allen patent, in view of the Fischer patent.

Claims 1, 4-7, and 10-15, generally define an article of footwear including an upper and a sole, wherein the sole has an outsole for directly contacting a ground surface, and further including at least one element compression molded with the outsole. The at least one element is formed from a first material comprising at least 45% ethylene vinyl acetate, approximately 30% polyene elastomer, and approximately 20% synthetic rubber. In addition, the at least one element has the specific performance property of showing no damage during a bending test performed at 23°C W. Prick or at -10°C Prick. The outsole includes a second material that is compatible for compression molding with the second material that is less hard and less dense than the first material.

The Allen patent discloses a golf shoe incorporating a spike socket spine frame system embedded in the outsole and extending throughout the shoe sole, for receiving all of the spike receptacles. The Allen patent teaches and claims (col. 6:9-37, and claim 5) that the spike socket spine be composed of a thermoplastic polyurethane ("TPU") which is preferably stiffened by the addition of 5-30 % of carbon or glass reinforcement fibers. The Allen patent fails to disclose the use of any material comprising ethylene vinyl acetate and certainly does not disclose the use of any material having a composition of at least 45% ethylene vinyl acetate, approximately 30% polyene elastomer, and approximately 20% synthetic rubber, i.e., Applicants' "ESS" blend. Also, Applicants in paragraph 0056 of the published application (2005/0005474 A1) go further and distinguish the use of a TPU from that of the claimed ESS blend by indicating that substitution of the ESS blend for TPU results in a reduction in sole weight of between 7.75% (i.e., reduction of 10 g from 129 g) and 25% (i.e., reduction of 32.5 g from 129 g). Finally, the Allen patent fails to disclose that the outsole is less dense than the frame; rather, it discloses only that the outsole is "softer" than the frame. Applicants state that the ESS material has a density of 0.84 g/cm^3 . The Examiner argues that because the Allen patent indicates that the frame TPU is harder and provides a "cushioning effect," the spine TPU of Allen must have a lower material density. Applicants maintain that it does not necessarily follow that a softer material must always have a lower material density. In fact, in one embodiment Applicants' ESS blend has a material density of 0.94 g/cm^3 (col. 3:1 of Applicants published application), whereas most TPU's have densities greater than 1, and according to the manufacturers specification, the preferred TPU used as the spine material by Allen, Isoplast 101 from Dow Chemical (col. 6:33-36) has a density of 1.19 g/cm^3 .

The Fischer patent fails to make up for these deficiencies of the Allen patent. The Fischer patent simply discloses a method of improving the Money viscosity and green strength of a specific EVA gum stock having between 40 to 70 wt % vinyl acetate by the addition of a 10-40 of another elastomer. However, Applicants note that the Fischer patent fails to disclose the use of any material having a composition of at least 45% ethylene vinyl acetate, approximately 30% polyene elastomer, and approximately 20% synthetic rubber. The Examiner cites col. 2, line 22 through col. 3, line 8, for the proposition that Fischer discloses the use of two elastomers. However, the cited paragraphs only disclose the use of one elastomer, which may also be

prepared with additional monomers such as for instance to render it a terpolymer rather than a copolymer. Nowhere does Fischer describe Applicants' three component ESS blend and certainly not the claimed specific relative ranges of each blend component. Finally, Fischer does not disclose the use of the blended EVA materials as a surrounding layer of a golf shoe cleat receptacle in a compression molded golf shoe outsole but rather only discloses uses such as adhesive formulation and PVC impact modifiers and various automotive applications.

For these reasons, the obviousness rejection of claims 1, 4-7, and 10-15 is improper and should be withdrawn.

II. The § 103(a) Rejection of Claim 3 Based on the Allen Patent in View of the Fischer and McKay Patents

As mentioned above, dependent claim 3 was rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Allen patent, in view of the Fischer patent, in further view of the McKay patent.

Claim 3 depends from independent claim 1. Applicants incorporate the arguments made above regarding the Allen and Fischer patents. The deficiencies of these patents are not remedied by the McKay patent, which fails to disclose or even suggest Applicants' specific combination of at least 45% ethylene vinyl acetate, approximately 30% polyene elastomer, and approximately 20% synthetic rubber.

For these reasons, the obviousness rejection of dependent claim 3 is improper and should be withdrawn.

III. The § 103(a) Rejection of Claims 8, 9, 16, and 17 Based on the Allen Patent in View of the Fisher and Safdie Patents

As mentioned above, claims 8, 9, 16, and 17 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Allen patent in view of the Fuller patent, and in further view of the Safdie patent.

Claims 8 and 9 depend from independent claim 1, and claims 16 and 17 depend from independent claim 11. Applicants incorporate the arguments made above regarding the

Allen and Fischer patents. The deficiencies of these patents are not remedied by the Safdie patent, which fails to disclose or even suggest Applicants' specific combination of at least 45% ethylene vinyl acetate, approximately 30% polyene elastomer, and approximately 20% synthetic rubber.

For these reasons, the obviousness rejection of claims 8, 9, 16, and 17 is improper and should be withdrawn.

IV. Conclusion

The foregoing remarks should place this application in condition for allowance. No new matter has been introduced by the foregoing amendments. If any matters remain outstanding after consideration of this Amendment that the Examiner believes might be expedited by a telephone conference with Applicants' representative, the Examiner is respectfully requested to call the undersigned attorney at the telephone number indicated below. As indicated in the transmittal form filed herewith, please charge any fees due in connection with this filing to our Deposit Account No. 19-1853.

Respectfully submitted,

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By: 

Bridgette A. Agness
Registration No. 59,596

Sheppard, Mullin, Richter & Hampton LLP
333 South Hope Street, 48th Floor
Los Angeles, California 90071
Telephone: (213) 620-1780 x4156
Facsimile: (213) 620-1398